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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH G. DE SOUZA,
SEAN WOODWARD,
and
JAMES W.D. FARE

Appeal 2008-004036
Application 09/992,363
Technology Center 3600

Decided:¹ June 15, 2009

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-31 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to issuing rewards to patrons of retail establishments. Upon detection of entry or departure from a retail establishment, a customer can be given award "points" analogous to frequent flyer-miles. (Specification 1:3-4 and 1:24-27). Claim 9, reproduced below, is representative of the subject matter of appeal.

9. A method, comprising:

- a) maintaining a score of bonus points for a customer;
- b) detecting entry of the customer through a portal; and
- c) in response to the entry, increasing the score.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Biffar	US 5,903,880	May 11, 1999
Ogasawara	US 6,513,015 B2	Jan. 28, 2003
Hardesty	US 2003/0078864 A1	Apr. 24, 2003

The following rejections are before us for review:²

1. Claims 9, 10, 22-23, and 28 are rejected under 35 U.S.C. § 102(e) as anticipated by Hardesty.
2. Claims 1-8, 11, 13-21, 24, 26, and 29-31 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ogasawara and Hardesty.
3. Claims 12, 25, and 27 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ogasawara, Hardesty, and Biffar.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 9, 10, 22-23, and 28 this issue turns on whether Hardesty reference shows a “portal” and that points are issued as a reward for visiting a website.

With regards to claims 1-8, 11-12, 13-21, 24-27, and 29-31 this issue turns on whether Ogasawra and Hardesty disclose bonus points awarded in the absence of a transaction and that there is a rationale to combine the references (Br. 12).

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:³

² We note that the rejection under 35 U.S.C. § 101 has been withdrawn by the Examiner (Ans. 7).

³ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF1. Hardesty discloses a rebate program for individuals where a rebate is transferred to a trust account (Abstract, Figure 1).

FF2. Hardesty discloses that it is known that incentives are provided to consumers to purchase goods or services either on or-off-line to “visit” certain web sites [0007].

FF3. Hardesty discloses that the incentives may be “points” or “airlines miles” [0007].

FF4. Ogasawara discloses a system for customer recognition using wireless identification and visual data transmission (Title).

FF5. Ogasawara discloses that the customer’s image or identification card is identified when they enter the store. The customer’s profile data, transaction history, and loyalty points are then forwarded to the stores workstations for the staff (Abstract).

FF6. Ogasawara discloses that a customer carrying a customer ID card enters an establishment, traverses a gate, and has the customer ID card interact with an interrogator antenna (Col. 8:55-63).

FF7. *The American Heritage® Dictionary of the English Language, Fourth Edition* (2009) lists the definition of “portal” to include: 1) A doorway, entrance, or gate, especially one that is large and imposing. 2) An entrance or a means of entrance: *the local library, a portal of knowledge*. 3) The portal vein. 4) A website considered as an entry point to other websites, often by being or providing access to a search engine. (Obtained from: <http://dictionary.classic.reference.com/browse/portal>) (last visited May 28, 2009).

PRINCIPLES OF LAW

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See*

also *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415 (citing *Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

Claims 9-10, 22-23, and 28

The Appellants have argued that the rejection of claim 9 under 35 U.S.C. § 102(e) as anticipated by Hardesty is improper because the reference is a faulty reference since it was published subsequent to the Appellants' filing date (Br. 10). The Appellants also argue that the term "portal" is not shown by the Hardesty reference (Br. 10-11, 18-20, 23-24 and Reply Br. 1-8). The Appellants also argue that the Hardesty reference does not show that points are issued as a reward for visiting a website (Br. 11-12, 15-17 and Reply Br. 19-20).

The Examiner has determined that the Hardesty reference is a proper reference to be applied under 35 U.S.C. § 102(e) (Ans. 8). The Examiner has also determined that the broadest reasonable interpretation of the term "portal" is broad enough to cover a "portal" in an Internet shopping environment (Ans. 8-9). The Examiner has also determined that Hardesty does show that points are rewarded for simply visiting a website (Ans. 9).

We agree with the Examiner. We note initially that Hardesty is a proper reference to be applied in this application as a reference under 35 U.S.C. § 102(e) since it has a filing date prior to that of this application.⁴

We first construe the meaning of the word "portal" as used by the Appellants in the claims. We determine the scope of the claims in patent applications "not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as

⁴ See the *Manual of Patent Examining Procedure* (MPEP) § 2136 and 35 U.S.C. § 102(e). Here the Hardesty reference is an application for patent for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent and thus meets the requirements of 35 U.S.C. § 102(e).

it would be interpreted by one of ordinary skill in the art.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). The Specification at page 7 does recite that “[t]he discussion above was framed in terms of a customer entering a door in a building. In the more general case, any type of portal to an enclosure is contemplated, such as a sports arena or stadium, or even a fenced area, such as fairground” (Spec. 7:1-4). However, the portion of the Specification to which this citation references states, “[t]he preceding example illustrates a specific embodiment of the invention” (Spec. 6:21). The Appellants’ Specification also references a server 27 and the Internet 30 (Fig. 1) which would imply that the Internet, and inherently an Internet portal, are accessed in the invention. We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004):

Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.

The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). Thus given that the conventional definition for “portal” is broad enough to include simply an “entrance” or “a point of entry to other

websites” (FF7) we decline to limit the scope of the claim here to be limited to a building portal of some kind since the Specification has provided only specific embodiments and does reference the Internet where a “portal” would be present. We remind appellants that it is their burden to precisely define the invention, not the PTO’s. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Appellants always have the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

The Appellants have also argued that the Hardesty reference does not show that points are issued as a reward for simply visiting a website (Br. 11-12). We disagree with this assertion. Hardesty has disclosed that it is known that incentives are provided to consumers to “visit” certain web sites (FF2). Hardesty also discloses that the incentives may be “points” or “airlines miles” (FF3). Thus, Hardesty has disclosed that points may be given for simply “visiting” certain web sites. For these reasons the rejection of claim 1 under 35 U.S.C. § 102(e) as anticipated by Hardesty is sustained. The rejection of claims 10 and 22-23 have not been separately argued and is sustained for these same reasons. The Appellants’ arguments for claim 28 are the same as presented for claim 1 and the rejection of the claim is sustained for the same reasons as claim 1.

Claims 1-8, 11-12, 13-21, 24-27, and 29-31

The Appellants argue that the rejection of claim 1 under 35 U.S.C. § 103(a) under Ogasawra and Hardesty is improper because there is no teaching that the references disclose bonus points awarded in the absence of

a transaction. (Br. 12-13, 32-33, 38-39, and Reply Br. 23). The Appellants also argue that the no rationale to combine the references (Br. 12, 39-40, and Reply Br. 20-22).

The Examiner has determined that Hardesty does shows that points are rewarded for simply visiting a website (Ans. 11). The Examiner has also determined that there is a rationale for combing the references to attract more customers by providing an incentive to merely visit the store (Ans. 10).

We agree with the Examiner. Hardesty has disclosed that it is known that incentives are provided to consumers to “visit” certain web sites (FF2). Hardesty also discloses that the incentives may be “points” or “airlines miles” (FF3). Thus, Hardesty has disclosed that points may be given for simply “visiting” certain web sites. Ogasawara discloses a system for customer recognition using wireless identification and visual data transmission (FF4). Ogasawara also discloses that a customer carrying a customer ID card can enter an establishment, traverses a gate, and have the customer ID card interact with an interrogator antenna (FF6). A transponder would be inherent between the customer ID card and interrogator antenna. The modification of the system of Ogasawara to have award points given for simply visiting the store as taught by Hardesty is considered an obvious, predictable use of prior art elements according to their established functions which would bring more customers to the store by providing loyalty points. For these reasons the rejection of claim 1 under 35 U.S.C. § 103(a) under Ogasawra and Hardesty is sustained. The rejection of claims 2-8, 11, 13, and 29-31 is sustained for these same reasons as well.

With regards to claims 14-21, 24, and 26 the Appellants have further argued that these claims include a “means-type” recitation for “detecting entry of the customer through a portal” which covers structure material, or

acts in the Specification and equivalents thereof (Br. 13). The Appellants further argues that the Appellants' Specification shows no identifying of visitors to a web site. The Appellants "means-type" claim language is directed to a "means for detecting entry of the customer through a portal" and shown in the Specification to be "known smart cards . . . known non-contact readers of smart cards . . . found in cellular telephones. . . and . . . PDAs" (Spec. 2:12-14).

Here such a "means" has been shown by Ogasawara in the customer ID card and interrogator antenna (FF6). The teaching of Hardesty was not used in the rejection to show "means for detecting entry of the customer through a portal" but only to show that that points may be given for simply "visiting" certain web sites. For these reasons, as well as those addressed above regarding claim 1, the rejection of claims 14-21, 24, and 26 under 35 U.S.C. § 103(a) under Ogasawara and Hardesty is sustained.

The Appellants have presented the same arguments for claims 12, 25, and 27 as addressed above. For these same above reasons the rejection of claims 12, 25, and 27 under 35 U.S.C. § 103(a) as unpatentable over Ogasawara, Hardesty, and Biffar is sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 9-10, 22-23, and 28 under 35 U.S.C. § 102(e) as anticipated by Hardesty.

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 1-8, 11, 13-21, 24, 26, and 29-31 under 35 U.S.C. § 103(a) as unpatentable over Ogasawara and Hardesty.

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We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 12, 25, and 27 under 35 U.S.C. § 103(a) as unpatentable over Ogasawara, Hardesty, and Biffar.

DECISION

The Examiner's rejection of claims 1-31 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

hh

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